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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,745	02/21/2002	David Raymond Posh	AUS920010933US1	5306
7590	05/31/2006			EXAMINER NGUYEN, MAIKHANH
Leslie A. Van Leeuwen IBM, Corp., Intellectual Property Law Dept. Internal Zip 4054 11400 Burnet Road Austin, TX 78758			ART UNIT 2176	PAPER NUMBER

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/082,745	POSH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Maikhahan Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 April 2006.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-24 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-24 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

***DETAILED ACTION***

1. This action is responsive to communications: Appeal Brief filed 04/04/2006 to the original application filed 02/21/2002.
  
3. Claims 1-24 are currently pending in this application. Claims 1, 9, and 17 are independent claims.
  
4. In view of the Appeal Brief filed on 04/04/2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.  
To avoid abandonment of the application, appellant must exercise one of the following two options:
  - (a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
  - (b) request reinstatement of the appeal.
  
5. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. CIT. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Uogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 C.F.R. ' 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. ' 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of application 09/752,337, now U.S. Pat. No. 7,017,118 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and patent'118 both directed to *swapping positions of segments/data items in a document*.

For example, independent claim 1 of the instant application claims:

**Claim 1.** A computer controlled user-interactive document editing display system comprising:

- means for defining one segment of displayed data in a displayed document;
- means for defining another segment of displayed data in said displayed document
- means for enabling a user to select to directly swap the one segment with the another segment;
- means, responsive to the swapping the positions of said segments of data with each other in a single step independently of separately identifying a new location for each of the one and other segments other than defining each segment responsive to a user selection to swap.

In contrast, independent claim 1 of patent'118 claims:

**Claim 1.** In a computer system having a user interface capable of displaying a plurality of data items and receiving user commands, a method comprising:

- receiving, through the user interface, a command to swap a first displayed data item with a second displayed data item;
- obtaining data identifying the first displayed data item;
- receiving, through the user interface, a directional command identifying a relative direction of a position of the second displayed data item to a position of the first displayed data item; and
- swapping the first displayed data item with the second displayed data item.

Because the instant claims merely alternatively claim limitations from the set of elements and functions claimed in patent'118, such modifications would be readily apparent to a programmer of ordinary skill.

*Claim Rejections - 35 USC § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

Claims 1-7, 9-15 and 17-23 are rejected under 35 U.S.C. 102(b) as being anticipated by

**Liu et al.** (U.S. 5,706,449 – issued 01/06/1998).

**As to claim 9:**

Liu teaches a method of user-interactive document editing on a display (*e.g., a graphical user interface controls ...manipulate lists of heterogeneous objects; col. 2, lines 54-56*) comprising:

- defining one segment of displayed data in a displayed document (*e.g., a list of columns with which the column whose heading was clicked....the user then select the desired column & highlights the heading of the column; col. 7, lines 10-40*);
- defining another segment of displayed data in said displayed document (*e.g., a list of columns with which the column whose heading was clicked ...the user then select the desired column; col. 7, lines 10-17*);
- enabling a user to select to directly swap the one segment with the another segment (*e.g., swaps the two columns; col. 7, lines 10-17*);and
- swapping the positions of said segments of data with each other in a single step independently of separately identifying a new location for each of the one and other segments other than defining each segment responsive to a user selection to swap (*e.g., enables the user to swap columns in the list control 46. In order to swap columns, the user selects "Swap" in the pop-up 64. The list control 46 then*

*displays a list of columns with which the column whose heading was clicked can be swapped. The user then selects the desired column. After receiving the user's selection, the list control 46 swaps the two columns; col. 7, lines 10-40).*

**As to claim 10:**

Liu teaches highlighting the one and another segments prior to swapping the positions of the segments (*e.g., clicking the heading of a column, selecting the desired column; col.7, lines 10-17*).

**As to claim 11:**

Liu teaches the displayed data in the swapped segments is alphanumeric text (*e.g., person number, last name; see fig. 17*).

**As to claim 12:**

Liu teaches the alphanumeric text in each of the swapped segment is a phrase (*e.g., text in columns; col.3, lines 27-35*).

**As to claim 13:**

Liu teaches the alphanumeric text in each of the swapped segments is a sentence (*e.g., text in columns to be swapped could be presented as a sentence; col.3, lines 27-35*).

**As to claim 14:**

Liu teaches the alphanumeric text in each of the swapped segments is a paragraph (e.g., *text in columns to be swapped could be presented as a paragraph; col.3, lines 27-35*).

**As to claim 15:**

Liu teaches the alphanumeric text in each of the swapped segments is at least one page in length (e.g., *text in columns to be swapped could be presented as a page in length; col.3, lines 27-35*).

**As to claims 1-7:**

Note the rejection of claims 9-15 above. Claims 1-7 are the same as claims 9-15, except claims 1-7 are system claims and claims 9-15 are method claims.

**As to claims 17-23:**

Note the rejection of claims 9-15 above. Claims 17-23 are the same as claims 9-15, except claims 17-23 are computer readable medium claims and claims 1-9 are method claims.

9. Claims 8, 16, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu in view of **Higashio** (U.S. 5,900,869 – issued 05/04/1999).

**As to claims 8, 16 and 24:**

Liu does not explicitly teach “swapping images.”

Higashio teaches swapping images (*col.3, lines 43-67 & fig.1*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Higashio in the system of Liu because it would have provided for editing by a plurality of users in an environment where one computer terminal can be sufficient shared in common.

***Response to Arguments***

10. Applicants' arguments filed 04/04/2006 have been fully considered but are moot in view of the new ground(s) rejection.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Carroll et al.            U.S. Pat. No. 7,017,118            Issued: Mar. 21, 2006

***Contact information***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-

4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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